

REMARKS

The office action dated July 22, 2005 has been carefully reviewed. Claims 1-13 are pending in this application. Claims 11 and 12 have been withdrawn. Reconsideration of this application is respectfully requested.

CLAIM REJECTIONS BASED ON §102

Claims 1, 3, 4, 8-10, and 13 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,645,594 issued to Devanathan et al. (hereinafter "Devanathan"). Applicants respectfully traverse this rejection. Reconsideration of claims 1, 3, 4, 8-10, and 13 is respectfully requested.

Discussion Re: Claim 1

Claim 1, as filed, is as follows:

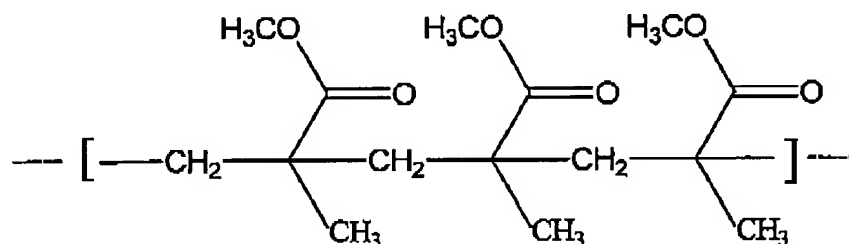
1. A method of making an implantable bearing for an orthopaedic prosthesis, comprising the steps of:
 providing a first layer constructed of a polymer;
 providing a second layer constructed of a copolymer comprising ethylene and an acrylate;
 securing said first layer to said second layer so as to create a composite; and
 forming said composite into a predetermined shape of said implantable bearing.

On page 2 of the 7/22/05 Office Action, the Examiner asserted:

Devanathan et al teach the claimed process as evident at col 2, lns 10-61 and fig 1-2. It should be noted that PMMA constitutes the claimed copolymer comprising ethylene and acrylate. It should also be noted that PMMA is given as an example of a copolymer comprising ethylene and acrylate (pg 7, lns 10-12 of the instant specification).

Applicants respectfully traverse this rejection. Specifically, contrary to the Examiner's assertion that all of the elements are disclosed in Devanathan, the step of "providing a second layer constructed of a copolymer comprising ethylene and an acrylate" is not. As such, the rejection is not supported by the art and should be withdrawn.

It appears from the above-cited passage from the 7/22/05 Office Action that the Examiner believes that PMMA satisfies the element "a copolymer comprising ethylene and an acrylate". Respectfully, this is simply not the case. The chemical structure of PMMA has been reproduced below for the Examiner's convenient reference.



As can be seen, although PMMA includes an acrylate, it clearly lacks ethylene. As such, PMMA could not be properly construed as "a copolymer comprising ethylene and an acrylate".

Applicants also respectfully traverse the Examiner's assertion that PMMA is given as an example in the Applicants' specification as a copolymer comprising ethylene and an acrylate. The complete sentence from the specification cited by the Examiner for such a notion is as follows:

The term "polymer" is also intended to include both homopolymers and copolymers; thus, "polymer" includes a copolymer comprising ethylene and acrylate, such as methyl methacrylate, methyl acrylate, ethyl methacrylate, ethyl acrylate and butyl methacrylate.

It appears that the Examiner's interpretation is that the specific compounds listed after the transition phrase "such as" (i.e., methyl methacrylate, methyl acrylate, ethyl methacrylate, ethyl acrylate and butyl methacrylate) are examples of a copolymer comprising

ethylene and an acrylate. In other words, it appears that the Examiner believes that this sentence indicates that PMMA is "a copolymer comprising ethylene and an acrylate" since methyl methacrylate is included in the list. However, Applicants intended the phrase "such as" to transition to a list of exemplary acrylates. In other words, methyl methacrylate was provided by Applicants as one of a number of exemplary acrylates that could be used as the "acrylate" component in a copolymer comprising ethylene and an acrylate, *but not as an example of the copolymer itself*. Applicants' explanation of their drafting intent is supported by the inescapable fact that polymerized methyl methacrylate (i.e., PMMA) does not include ethylene as described above.

In summary, contrary to the Examiner's assertion in the 7/22/05 Office Action, PMMA is not a copolymer comprising ethylene and an acrylate. As a result, the Examiner has not established a prima facie case of anticipation, and the rejection of claim 1 should be withdrawn.

Discussion Re: Claims 3, 4, 8-10, and 13

Each of claims 3, 4, 8-10, and 13 includes claim 1 as a base claim. As such, a prima facie case of anticipation has not been established in regard to claims 3, 4, 8-10, and 13 for at least the reasons discussed in regard to claim 1.

CLAIM REJECTIONS BASED ON §103

Claims 2 and 5-7 were rejected under 35 U.S.C. §103 as being obvious over Devanathan. Each of claims 2 and 5-7 includes claim 1 as a base claim. Since a prima facie rejection has not been established in regard to claim 1, the rejection of dependent claims 2 and 5-7 should be withdrawn.

CONCLUSION

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

In the event that there are any questions related to this response in particular, or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 265280-68188.

Respectfully submitted,

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